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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

for the U.S. Application of

Paul SIDIKMAN et al.

Group Art Unit: 2164

U.S. Serial No.: 09/006,839

Examiner: Kazimi, H.

Filed: January 12, 1998

For: METHOD AND SYSTEM FOR PROVIDING INTEGRATED BROKERAGE AND OTHER FINANCIAL SERVICES THROUGH CUSTOMER ACTIVATED TERMINALS

Commissioner For Patents
Washington, D.C. 20231

RESPONSE

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Sir:

This is in full and timely response to the non-final Office Action as mailed on January 16, 2002. Claims 19-37 are currently pending in the present application. Reconsideration of this application is respectfully requested in view of the following remarks.

In the above-mentioned Office Action, the Patent Office (PTO) rejected claims 19-37 under 35 U.S.C. 102(a) based upon a public use or sale as evidenced by the article, "Trade it Yourself Bank Machines Make a Debut Securities," Los Angeles Times, October 6, 1994 (hereinafter referred to as "the cited newswire"). This rejection is respectfully traversed for at least the following reasons.

As admitted by the PTO, "if the article [the cited newswire] *actually anticipates* the claims and can be used under 102, then the rejection can still stand (sic) under 102(a) even if they are commonly assigned." (Emphasis added). Office Action of 1/16/2002, p. 3. Yet, according to MPEP 2131 regarding *anticipation* and the application of 35 U.S.C. 102(a), (b), and (e), "[a] claim is *anticipated* only if each and every element as set forth in the claim is

found, either expressly or inherently described, in a single prior art reference.” (Emphasis added). (Quoting Verdegaal Bros. v. Union Oil Col. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

It is respectfully submitted that the purported teaching in the cited newswire is sparse and unclear and does not disclose Applicants’ invention *as claimed*, which is a requirement for any asserted prior art rejection under 35 U.S.C. 102(a), as confirmed by MPEP 2131. For instance, the cited newswire discusses generally the use of automated teller machines (ATMs) by customers to buy and sell stocks and mutual funds and check balances in brokerage accounts. There is no discussion in the cited newswire of the actual method and detailed steps set forth in at least independent claim 19 of the present invention. At most, the cited newswire describes,

“The Citibank system pivots on specially designed automated teller machines that have separate ‘menus’ for banking and brokerage services. Customers who want to access their stock account will select a button that says ‘brokerage services: Not FDIC insured.’” The cited newswire, third paragraph from the last.

And that,

“The [ATM] screen offers a choice between information or trading. If you choose to trade, the next screen is a full-page of disclosure about stock market risks. Those who just want to check stock prices will pull up a picture of a typewriter keyboard. By touching the screen, they can type in the name of the company or its sticker symbol and get a real-time stock quote or the previous day’s mutual fund closing price.” Id., last two paragraphs.

Hence, the cited newswire does not expressly or inherently describe each and every element as set forth in independent claim 19, such as at least those elements highlighted in the recitation of the claim below.

19. (Recited) A method for a user at an automatic teller machine to obtain securities information and transactions, comprising:
the user accessing the automatic teller machine;
the automatic teller machine prompting the user with an option to perform securities functions;
the user selecting the option to perform securities functions;

automatically prompting the user to select a securities function from a securities function group of obtain information, buy securities, and sell securities;
the user selecting a securities function from the securities function group;
if the user selects the securities function of obtain information, automatically prompting the user to select one information type from an information type group of holdings, stock quotes, symbol directory, and activity and orders;
the user selecting an information type from the information type group;
providing to the user information for the selected information types;
if the user selects one securities function from the securities function group of buy securities and sell securities, automatically determining whether the user has established a linked brokerage account;
if the user has established a linked brokerage account, automatically determining whether the user has multiple brokerage accounts;
if the user does not have multiple brokerage accounts, automatically presenting the user with a portfolio profile message;
automatically determining whether a broker system is available;
if a broker system is available, automatically determining whether trading is enabled; and
performing a trading request for enabled trading.

Accordingly, it is respectfully submitted that claim 19 is allowable over the cited newswire and all references of record. Dependent claims 20-37 further include elements/limitations neither expressly nor inherently described in the cited newswire. Hence, claims 20-37 are also allowable over the references of records.

Conclusion

For at least all of the above reasons, it is respectfully submitted that the present invention is neither disclosed nor suggested by the references of record, and the claims now pending patentably distinguish the present invention from the references of record. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned at the number listed below.

Respectfully submitted,

Date: 7/16/02

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